IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	Younghee JUNG *et al.*	Confirmation No.:	3679
Application No.:	10/786,705	Group Art Unit:	2161
Filed:	February 24, 2004	Examiner:	Padmanabhan, Kavita

For: SYSTEM AND METHOD FOR THE PROVISION OF SOCIALLY-
        RELEVANT RECOMMENDATIONS

Commissioner for Patents
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

This Appeal Brief is submitted in support of the Notice of Appeal dated April 29, 2010.

I.   REAL PARTY IN INTEREST

Nokia Corporation is the real party in interest.

II.   RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III.   STATUS OF THE CLAIMS

Claims 1 through 15, 17 through 23, 48 through 62, 64 through 70 and 95 through 102 are

pending in this appeal, in which claims 16, 24 through 47, 63, and 71 through 94 have previously

been canceled, claims 3, 4, 7, 8, 10 through 12, 19, 20, 22, and 23 are original claims, and claims

1, 2, 5, 6, 9, 13 through 15, 17, 18, 21, 48 through 62, 64 through 70, and 95 through 102 have been previously presented.

Claims 1 through 15, 17 through 23, 48 through 62, 64 through 70 and 95 through 102 were finally rejected in an Office Action dated January 29, 2010. This Appeal is taken from the final rejection of claims 1 through 15, 17 through 23, 48 through 62, 64 through 70 and 95 through 102 on January 29, 2010.

IV.   STATUS OF AMENDMENTS

No Amendment has been filed subsequent to the issuance of the Final Office Action on January 29, 2010.

V.   SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention relates to communication between hand-held devices. In particular, a first hand-held device and second hand-held device communicate via short range communication, at least one of the hand-held devices determines a match between data related to the hand-held devices and provides a user with a recommendation.

Independent claim 1 recites:

1. A method, comprising:

receiving data at a first hand-held device from a second hand-held device via short range communication (See, e.g. Specification ¶¶ [0029], [0030], [0051]), wherein the data includes a connection log, of the second hand-held device, that specifies information relating to a previously established communication connection between the second hand-

held device and one or more other hand-held device (See, e.g. Specification ¶¶ [0021], [0022], [0074], [0082]);

determining, at the first hand-held device, a match between the data received at the first hand-held device and other data associated with one or more other hand-held device within a short-range communication range of the first hand-held device, wherein the other data includes a connection log, of the first hand-held device, that specifies information relating to a previously established communication connection between the first hand-held device and the one or more other hand-held device (See, e.g. Specification ¶¶ [0034], [0039], [0040], [0043], [0046], [0066], [0076], [0080]);

creating, at the first hand-held device, a log entry in accordance with the match (See, e.g. Specification ¶¶ [0143] through [0146]); and

generating a recommendation for presentation to a user of the first hand-held device in accordance with the match (See, e.g. Specification ¶¶ [0132] through [0135], [0153]).

Independent claim 48 recites:

48. A hand-held apparatus, comprising:

a memory having program code stored therein (See, e.g. Specification ¶¶ [0180], [0183]); and

a processor disposed in communication with the memory for carrying out instructions in accordance with the stored program code (See, e.g. Specification ¶¶ [0180], [0183]);

wherein the processor, in accordance with the program code, is configured to (See, e.g. Specification ¶¶ [0180] through [0182]):

receive data from a second hand-held apparatus via short range communication (See, e.g. Specification ¶¶ [0029], [0030], [0051]), wherein the data includes a connection log, of the second hand-held device, that specifies information relating to a previously established communication connection between the second hand-held device and one or more other hand-held device (See, e.g. Specification ¶¶ [0021], [0022], [0074], [0082]);

determine a match between the received data and other data associated with one or more other hand-held apparatuses within a short-range communication range, wherein the other data includes a connection log, of the first hand-held device, that specifies information relating to a previously established communication connection between the first hand-held device and the one or more other hand-held device (See, e.g. Specification ¶¶ [0034], [0039], [0040], [0043], [0046], [0066], [0076], [0080]);

create a log entry in accordance with the match (See, e.g. Specification ¶¶ [0143] through [0146]); and

generate a user targeted recommendation for presentation in accordance with the match (See, e.g. Specification ¶¶ [0132] through [0135], [0153]).

Independent claim 95 recites:

95. A hand-held apparatus, comprising:

hardware means for receiving data from a second hand-held apparatus via short range communication (See, e.g. Specification ¶¶ [0029], [0030], [0051]), wherein the data includes a connection log, of the second hand-held device, that specifies information relating to a previously established communication connection between the second hand-

held device and one or more other hand-held device (See, e.g. Specification ¶¶ [0021], [0022], [0074], [0082]);

hardware means for determining a match between the received data and other data associated with one or more other hand-held apparatuses within a short-range communication range, wherein the other data includes a connection log, of the first hand-held device, that specifies information relating to a previously established communication connection between the first hand-held device and the one or more other hand-held device (See, e.g. Specification ¶¶ [0034], [0039], [0040], [0043], [0046], [0066], [0076], [0080]);

hardware means for creating a log entry in accordance with the match (See, e.g. Specification ¶¶ [0143] through [0146]); and

hardware means for generating a user targeted recommendation for presentation in accordance with the match (See, e.g. Specification ¶¶ [0132] through [0135], [0153]).

Independent claim 96 recites:

96. A hand-held apparatus, comprising:

a memory having program code stored therein (See, e.g. Specification ¶¶ [0180], [0183]);

a processor disposed in communication with the memory for carrying out instructions in accordance with the stored program code (See, e.g. Specification ¶¶ [0180], [0182]); and

a short-range communications interface disposed in communication with the processor (See, e.g. Specification ¶¶ [0029], [0030], [0051]); wherein the processor, in accordance with the program code, is configured to (See, e.g. Specification ¶¶ [0180] through [0182]):

determine a match between data received, via the short-range communications interface, from a second hand-held apparatus and other data associated with one or more other hand-held

apparatuses within a short-range communication range, wherein the received data includes at least an identifier for data associated with the one or more other hand-held apparatuses within the short-range communication range and a connection log (See, e.g. Specification ¶¶ [0145], [0177]), of the second hand-held apparatus, that specifies information relating to a previously established communication connection between the second hand-held apparatus and one or more other hand-held apparatus, and the other data includes a connection log, of the first hand-held apparatus, that specifies information relating to a previously established communication connection between the first hand-held apparatus and the one or more other hand-held apparatus (See, e.g. Specification ¶¶ [0034], [0039], [0040], [0043], [0046], [0066], [0076], [0080]);

create a log entry in accordance with the match (See, e.g. Specification ¶¶ [0143] through [0146]); and

generate, a user targeted recommendation for presentation in accordance with the match (See, e.g. Specification ¶¶ [0132] through [0135], [0153]).

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 1 through 3, 6, 7, 9 through 15, 17, 19 through 22, 48 through 50, 53, 54, 56 through 62, 64, 66 through 69, and 95 through 102 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon *Burr* in view of *Ryan et al.*

B. Claims 8 and 55 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon *Burr* in view of *Ryan et al.* further in view of *Robertson.*

C. Claims 23 and 70 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon *Burr* in view of *Ryan et al.* further in view of *Tsou et al.*

D. Claims 18 and 65 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon *Burr* in view of *Ryan et al.* further in view of *Young et al.*

E. Claims 4 and 51 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon *Burr* in view of *Ryan et al.* further in view of *Bieganski et al.*

F. Claims 5 and 52 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon *Burr* in view of *Ryan et al.* further in view of *Spooner.*

VII. ARGUMENT

GROUPING OF CLAIMS

For the convenience of the Honorable Board of Patent Appeals and Interferences ("Board"), Appellants do not separately argue the patentability of any dependent claim. Instead, the patentability of all dependent claims stands and falls with their respective independent claims, i.e., independent claims 1, 48, 95, and 96. Since all independent claims include the same or similar distinctive features, Appellants select independent claim 1 of the group of independent claims to argue. As such, the patentability of all of the appealed claims, including independent claims 48, 95, and 96, stands and falls with independent claim 1. Appellants will therefore focus on Rejection A above that includes independent claim 1.

A. CLAIMS 1 THROUGH 3, 6, 7, 9 THROUGH 15, 17, 19 THROUGH 22, 48 THROUGH 50, 53, 54, 56 THROUGH 62, 64,66-69, AND 95 THROUGH 102 ARE NOT OBVIOUS OVER *BURR* IN VIEW OF *RYAN ET AL.*

The Examiner bears initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision. *Gilbert & P. Hyatt v. Dudas*, 551 F.3d 1307, 1313 (Fed. Cir. 2008); *In re Glaug*, 283 F.3d 1335 (Fed. Cir. 2002*); In re Rijkaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1992); *In re Oetiker*, 977 F.2d 1992*); In re Piasecki*, 745 F.2d 1468 (Fed.

Cir. 1984). *See, also, M.P.E.P. §2144 II.A.* In rejecting a claim under 35 U.S.C. §103(a), the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). Further, in rejecting a claim under 35 U.S.C. §103(a) it is incumbent upon the Examiner to establish the requisite motivation. As maintained by the Supreme Court of the United States in *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727 at 1741, an obviousness "analysis should be made explicit." See, *In re Kahn*, 441 F.3d 977, 988 (C.A. Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusions of obviousness"). Indeed, the Examiner is required to make specific factual findings, not generalizations. *See M.P.E.P. §2144.08 II. A. 5.* That initial burden required by procedural **due process of law** has not been discharged.

In rejecting claim 1, the Examiner admitted that *Burr* does not disclose the concept "generating a recommendation for presentation to a user of the first hand-held device in accordance with the match." The Examiner attempted to fill this gap between the claimed invention and the primary reference to *Burr* by stating that "Ryan teaches generating a recommendation for presentation to a user of the first hand-held device in accordance with the match **(Ryan; pars [0232]-[0235] – presents recommendation that user A and B establish contact)**" (See, page 3, lines 18-20 of Office Action). Appellants disagree.

It is readily apparent and would have been understood by one having ordinary skill in the art that, as a factual matter, *Ryan et al.* do not teach, at least "**generating a recommendation for presentation to a user of the first hand-held device in accordance with the match.**" (Emphasis

added). Indeed, the relied-upon paragraphs of *Ryan et al.* describe a situation where a User A finds a stranger B through a system, who is a friend of friend C at a sport-stadium (See, paragraph [0232] of *Ryan et al.*). It is in that context that *Ryan et al.* disclose a method for allowing User A to acquire User B's reputation by contacting User C manually (See paragraphs [0234], [0235] of *Ryan et al.*). User A is notified by SMS when stranger B is within proximity of User A. It is not apparent and the Examiner did not discharge the initial burden by pointing out where in *Ryan et al.* there is any recommendation for presentation associated with the SMS. In fact there is **no recommendation** for presentation associated with the SMS in *Ryan et al.*

More specifically, in *Ryan et al.*, "User A is interested to communicate with User B, but **only after checking with User C** about the person" (emphasis added) (paragraph [0234]). For User A to reach User C directly, "User A will **simply call or send a text-message to User C**" (emphasis added) (paragraph [0234]). The system might "give User A the **option to** be placed directly into contact via voice or data with User C" (emphasis added) (paragraph [0234]). After User C replies positively to User A's interest in contacting User B, User A responds to the original alert message (Paragraph [0235]). According to *Ryan et al.*, User A either manually calls or sends a text-message to User C and User C manually responds to User A's inquiry regarding User B to provide a recommendation. In other words, at best *Ryan et al.* may be said to suggest merely presenting an option to call or send a text-message to a user. It is readily apparent, and would have been understood by one having ordinary skill in the art, that the above procedure described in *Ryan et al.* is completely **different from** the recited claim features, "**generating a recommendation for presentation to a user** of the first hand-held device **in accordance with the match**" (emphasis added), which include generating a recommendation for the user.

Based on the foregoing, it is apparent that *Ryan et al.* neither disclose nor suggest the features of the claimed invention that are admittedly missing from the primary reference to *Burr*. Therefore, even if, for the sake of argument, the applied references are combined as proposed by the Examiner, and Appellants do not agree that the requisite basis for the asserted motivation has been established, the invention defined in independent claim 1 would not result.

As noted above, the patentability of claims 2 through 15, 17 through 23, 48 through 62, 64 through 70 and 95 through 102 stands and falls with claim 1. Additionally, the tertiary references cited in the above-identified Rejections B, C, D, E, and F are not directed towards the above argued distinct claim features and thus do not cure the deficiencies in the attempted combination of *Ryan et al.* and *Burr*. Appellants therefore submit that none of the Examiner's rejections under 35 U.S.C. § 103(a) is factually or legally viable.

VIII. CONCLUSION AND PRAYER FOR RELIEF

Based on the foregoing, it is apparent that none of the Examiner's rejections under 35 U.S.C. § 103(a) is factually or legally viable. Appellants therefore solicit the Honorable Board to reverse each of the Examiner's rejections.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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IX. CLAIMS APPENDIX

1. A method, comprising:

receiving data at a first hand-held device from a second hand-held device via short range communication, wherein the data includes a connection log, of the second hand-held device, that specifies information relating to a previously established communication connection between the second hand-held device and one or more other hand-held device;

determining, at the first hand-held device, a match between the data received at the first hand-held device and other data associated with one or more other hand-held device within a short-range communication range of the first hand-held device, wherein the other data includes a connection log, of the first hand-held device, that specifies information relating to a previously established communication connection between the first hand-held device and the one or more other hand-held device;

creating, at the first hand-held device, a log entry in accordance with the match; and

generating a recommendation for presentation to a user of the first hand-held device in accordance with the match.

2. The method of claim 1, wherein the data received at the first hand-held device further includes at least an identifier for data held by the second hand-held device.

3. The method of claim 2, wherein the identifier is a unique identifier.

4. The method of claim 2, wherein the identifier is an international standard book number.

5. The method of claim 2, wherein the identifier is an international mobile equipment identity identifier.

6. The method of claim 2, wherein the data received at the first hand-held device further includes a data element held by the second hand-held device.

7. The method of claim 6, wherein the data element is a phone number.

8. The method of claim 6, wherein the data element is a universal resource locator.

9. The method of claim 1, wherein the data received at the first hand-held device is not browsable by the user.

10. The method of claim 1, further comprising: determining if the user already possesses data relating to the recommendation.

11. The method of claim 1, wherein the recommendation is provided at a particular period of time after the one or more criteria have been met.

12. The method of claim 1, wherein the recommendation is provided at a particular time of day after one or more criteria have been met.

13. The method of claim 1, wherein the recommendation is provided after the user performs an operation with the first hand-held device.

14. The method of claim 1, wherein the recommendation suggests to the user addition of data relating to the data received at the first hand-held device.

15. The method of claim 14, wherein the data suggested for addition is held by the second hand-held device.

16. (Canceled)

17. The method of claim 1, wherein bluetooth is employed for the short-range communications.

18. The method of claim 1, wherein a one-way hash of a unique identifier associated with the second hand-held device is employed in creating the log entry.

19. The method of claim 1, wherein one or more criteria provide for weighting of log entries.

20. The method of claim 1, wherein the recommendation is not provided after expiration of a validity period.

21. The method of claim 1, wherein the data received at the first hand¬held device is updated.

22. The method of claim 1, wherein the user is directed to a source for information regarding data suggested by the recommendation.

23. The method of claim 1, wherein an advertiser learns if the user complied with the recommendation.

24. - 47. (Canceled)

48. A hand-held apparatus, comprising:

a memory having program code stored therein; and

a processor disposed in communication with the memory for carrying out instructions in accordance with the stored program code;

wherein the processor, in accordance with the program code, is configured to:

receive data from a second hand-held apparatus via short range communication, wherein the

data includes a connection log, of the second hand-held device, that specifies information

relating to a previously established communication connection between the second hand-

held device and one or more other hand-held device;

determine a match between the received data and other data associated with one or more other

hand-held apparatuses within a short-range communication range, wherein the other data

includes a connection log, of the first hand-held device, that specifies information relating

to a previously established communication connection between the first hand-held device

and the one or more other hand-held device;

create a log entry in accordance with the match; and

generate a user targeted recommendation for presentation in accordance with the match.

49. The hand-held apparatus of claim 48, wherein the received data further includes at least
an identifier for data held by said hand-held apparatus within the short-range communication
range.

50. The hand-held apparatus of claim 49, wherein the identifier is a unique identifier.

51. The hand-held apparatus of claim 49, wherein the identifier is an international standard
book number.

52. The hand-held apparatus of claim 49, wherein the identifier is an international mobile
equipment identity identifier.

53. The hand-held apparatus of claim 49, wherein the received data further includes a data
element held by said hand-held apparatus within the short-range communication range.

54. The hand-held apparatus of claim 53, wherein the data element is a phone number.

55. The hand-held apparatus of claim 53, wherein the data element is a universal resource locator.

56. The hand-held apparatus of claim 48, wherein the received data is not user browsable.

57. The hand-held apparatus of claim 48, wherein the processor is further configured to determine if data relating to the recommendation is already user possessed.

58. The hand-held apparatus of claim 48, wherein the recommendation is provided at a particular period of time after the one or more criteria have been met.

59. The hand-held apparatus of claim 48, wherein the recommendation is provided at a particular time of day after one or more criteria have been met.

60. The hand-held apparatus of claim 48, wherein the recommendation is provided after a user operation.

61. The hand-held apparatus of claim 48, wherein the recommendation suggests addition of data relating to the received data.

62. The hand-held apparatus of claim 61, wherein the data suggested for addition is held by said hand-held apparatus within the short-range communication range.

63. (Canceled)

64. The hand-held apparatus of claim 48, wherein bluetooth is employed for the short-range communications.

65. The hand-held apparatus of claim 48, wherein a one-way hash of a unique identifier associated with said hand-held apparatus within the short-range communication range is employed in creating the log entry.

66. The hand-held apparatus of claim 48, wherein one or more criteria provide for weighting of log entries.

67. The hand-held apparatus of claim 48, wherein the recommendation is not provided after expiration of a validity period.

68. The hand-held apparatus of claim 48, wherein the received data is updated.

69. The hand-held apparatus of claim 48, wherein there is user direction to a source for information regarding data suggested by the recommendation.

70. The hand-held apparatus of claim 48, wherein an advertiser learns if user compliance with the recommendation occurred.

71. - 94. (Canceled)

95. A hand-held apparatus, comprising:

hardware means for receiving data from a second hand-held apparatus via short range communication, wherein the data includes a connection log, of the second hand-held device, that specifies information relating to a previously established communication connection between the second hand-held device and one or more other hand-held device;

hardware means for determining a match between the received data and other data associated with one or more other hand-held apparatuses within a short-range communication range,

wherein the other data includes a connection log, of the first hand-held device, that specifies information relating to a previously established communication connection between the first hand-held device and the one or more other hand-held device;

hardware means for creating a log entry in accordance with the match; and

hardware means for generating a user targeted recommendation for presentation in accordance with the match.

96. A hand-held apparatus, comprising:

a memory having program code stored therein;

a processor disposed in communication with the memory for carrying out instructions in accordance with the stored program code; and

a short-range communications interface disposed in communication with the processor; wherein the processor, in accordance with the program code, is configured to:

determine a match between data received, via the short-range communications interface, from a second hand-held apparatus and other data associated with one or more other hand-held apparatuses within a short-range communication range, wherein the received data includes at least an identifier for data associated with the one or more other hand-held apparatuses within the short-range communication range and a connection log, of the second hand-held apparatus, that specifies information relating to a previously established communication connection between the second hand-held apparatus and one or more other hand-held apparatus, and the other data includes a connection log, of the first hand-held apparatus, that specifies information relating to a previously established communication connection between the first hand-held apparatus and the one or more other hand-held apparatus;

create a log entry in accordance with the match; and

generate, a user targeted recommendation for presentation in accordance with the match.

97. The method of claim 1, further comprising:

transmitting, to the second hand-held device via the short range communication, information corresponding to the log entry.

98. The hand-held apparatus of claim 48, wherein the processor, in accordance with the program code, is further configured to:

transmit, to the second hand-held device via the short range communication, information corresponding to the log entry.

99. The hand-held apparatus of claim 95, further comprising:

hardware means for transmitting, to the second hand-held device via the short range communication, information corresponding to the log entry.

100. The hand-held apparatus of claim 96, wherein the processor, in association with the short-range communications interface, is further configured to:

transmit, to the second hand-held device via the short range communication, information corresponding to the log entry.

101. The method of claim 1, wherein the connection log information includes either connection type, connection duration, time of connection, date of connection, or a combination thereof.

102. The method of claim 1, wherein the data from the second hand-held device further includes address book information or information about content stored on the second hand-held device.

X.   <u>EVIDENCE APPENDIX</u>

Appellants are unaware of any evidence that is required to be submitted in the present Evidence Appendix.

XI.   **RELATED PROCEEDINGS APPENDIX**

Appellants are unaware of any related proceedings that are required to be submitted in the present Related Proceedings Appendix.